

REMARKS

Claims 7-14 and new claims 32-35 are pending in this application. Claims 1-6 and 15-27 were previously canceled and claims 28-31 are canceled by this amendment. Claim 7 has been allowed as indicated on p.26 of the Office Action.

The claim amendments and new claims are supported in the patent and the priority document as follows:

Claims 12-14: Based on previous claim, now claiming the compound instead of the material containing the compound and the compound;

New Claim 32 and 34-35: Based on Claim 12; and

New Claim 33: Based on Claim 14.

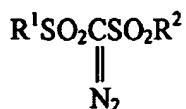
The Applicants respectfully submit that no new matter has been added.

Claims 12-14 and 28-31 are rejected under 35 USC 251 as being broadened in a reissue application filed outside the two year statutory period. (Office Action p.2)

The Applicants assert that because of the chemistry of this reissue application having claims directed to the *compound of the original patent* combined with a carrier resin, claims 12-14 and 28-31 are not broader than the original patent because any conceivable product having the *compound of the original patent* would, of course, have infringed the original patent. There could be no conceivable product that could infringe current claims 12-14 and 28-31 without infringing the original patented claims as well. In other words, because the *original patented compound is present in all the claims*, original and reissue application claims, any product containing such a compound would infringe the original patented claims.

Therefore in this unique case, claims 12-14 and 28-31 are not broader in scope because they fail the asserted test, namely, "A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent."

To be certain there can be no question about the current claims being broader in scope than the original patented claims, Claims 12-14 have been amended to recite only a compound of the formula:



and not resist material comprising a diazodisulfone and a polymer.

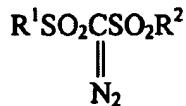
As currently amended the scope of claims 12-14 are *now narrower* than that of the original patented claims, because they recite the compound of the same formula of original claims *in addition to further limitations*. In such a case, the patent owner could not, if a reissue patent issues with the combination claims, sue any new party for infringement who could not have been sued for infringement of the original patent. Therefore, broadening does not exist, because claims 12-14 are narrower than the original claims.

In addition to the compound of the original patent, claim 12 recites the following "wherein" clause:

wherein the resist compound is used for a light source of 300 nm or less at a reduced light exposure energy amount to generate an acid to create a positive tone pattern on a surface having a polymer, which is difficultly soluble in an alkaline developing solution but which can become soluble by the action of an acid, and the resist compound is sufficient for the polymer on an exposed portion

to become alkali-soluble by a chemical change with the acid generated from the resist compound by light exposure energy.

Obviously, this limitation does not broaden a claim reciting a compound of the formula:



instead, the "wherein" clause narrows such a claim.

The claims are not now broader in any respect than the original claims.

Claims 28-31 have been canceled by this amendment, making the rejection of these claims now moot.

It is believed that the amendments overcome the rejection.

Claims 10 and 11 are objected to as being substantial duplicates of claims 8 and 9.

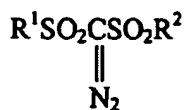
(Office Action p.4)

In response to this objection the Applicants assert the argument in the December 14, 2004 amendment. Again, Applicants request to defer the canceling of claims 10 and 11, if necessary, until the allowance of all claims 8-11.

Claims 12-14 and 28-31 are rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. (Office Action p.5)

Claims 28-31 have been canceled by this amendment, making the rejection now moot.

Claims 12-14 have been amended to recite a compound of the formula:



According to the Office Action, no particular support could be found for points a)-h). In response the Applicants assert:

- a) The claims, as now amended, no longer contain the phrase "resist material."
- b) The specific support for claims 12 and 13 is found as follows:

Claim 12: (Patent: col.2, lines 9-12 and 25-26, col.13, line 34 and lines 50-68; Priority: p.4, lines 1-5, p. 9, lines 1-5, p.14, lines 5-10, p.20, line 12); and

Claim 13: (Patent: col.2, lines 25-26; Priority: p.4, lines 3-5).

- c) The surface is obviously the surface on which the resist compound is placed or coated. In this case "a surface" is not being explicitly claimed, only referred to by implication.
- d) The expression was amended to "light exposure energy" as helpfully suggested by the Examiner.
- e) The claims, as now amended, no longer contain the phrase "an effective amount."
- f) The expression "sufficient for the polymer" has been removed.
- g) Claims 28-31 have been canceled making this rejection now moot.
- h) Claims 30-31 have been canceled making this rejection now moot.

It is believed that the amendments overcome the rejection.

Claims 8 and 9 are rejected under 35 USC 112, first paragraph, based on the written description requirement. (Office Action p.5)

In response to this rejection the Applicants assert the argument in the December 14, 2004 amendment. It is believed that this argument addresses and overcomes the rejection.

Claims 12-14 and 28-31 are rejected under 35 USC 112, as being indefinite. (Office Action p.14)

As for Claims 12 and 14, the expression "difficulty soluble" has been amended to read "difficultly soluble" as thoughtfully suggested by the Examiner.

Claims 28-31 have been canceled by this amendment, making the rejection of these claims now moot.

Claims 8-14 are rejected under 35 USC 102(e) as being anticipated by Pawlowski et al. (USP 5,338,641). (Office Action p.16)

In response to this rejection the Applicants assert the argument in the December 14, 2004 amendment. It is believed that this argument addresses and overcomes the rejection.

Claims 12-14 are rejected under 35 USC 102(f) or (g) as being anticipated by Pawlowski et al. (USP 5,338,641). (Office Action p.20)

Claims 12-14 have been amended to recite a compound, and they no longer recite a compound and a binder. Therefore this rejection is now moot.

U.S. Patent Reexam No. 90/004,812

U.S. Patent: 5,216,135

Reply to OA of April 21, 2005

Claims 9 and 11-14 are rejected under 35 USC 103(a) as being obvious over Pawlowski et al. (USP 5,338,641). (Office Action p.13).

Applicants respectfully urge that claims 9 and 11 are not rendered obvious by Pawlowski'641 as explained on p. 6-9 of the response filed on February 4, 2004.

Claims 12-14 are not obvious from the disclosure of Pawlowski'641 for several reasons as explained in the December 14, 2004 amendment.

Simply stated, the reduced light exposure resist compound which is used for a light source of 300nm or less is both novel and unobvious and has been a part of the Applicants' invention since the filing of the priority document on January 30, 1990.

Based on the showing above, it is respectfully requested that all claims be allowed.

U.S. Patent Reexam No. 90/004,812

U.S. Patent: 5,216,135

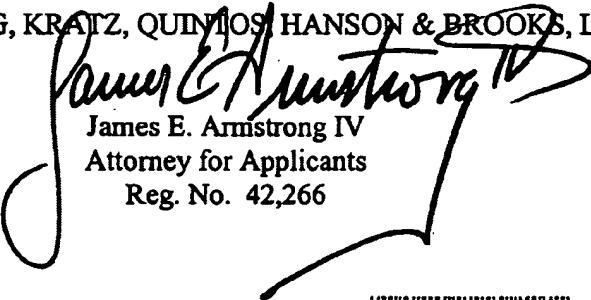
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If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the Applicants' undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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